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TRANSMITTAL LETTER
INFORMATION DISCLOSURE STATEMENT

Applicant : Datta, et al.
App. No : 10/648,585
Filed : August 25, 2003
For : SYNTHETIC MICROSPHERES AND
METHODS OF MAKING SAME
Examiner : Unknown
Art Unit : Unknown

CERTIFICATE OF MAILING

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on

August 31, 2005

(Date)

Linda H. Liu, Reg. No. 51,240

Mail Stop Amendment

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed for filing in the above-identified application are:

- (X) An Information Disclosure Statement and PTO/SB/08 equivalent listing references for consideration:
 - (X) Listing 1 reference.
 - (X) Enclosing 1 reference.
- (X) The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 11-1410.
- (X) Return prepaid postcard.

Linda H. Liu
Registration No. 51,240
Attorney of Record
Customer No. 20,995
(951) 781-9231



INFORMATION DISCLOSURE STATEMENT

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Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed for filing in the above-identified application is a PTO/SB/08 Equivalent listing one reference to be considered by the Examiner.

Pursuant to the provisions of M.P.E.P. § 2001.06(c), the Applicant brings to the attention of the Examiner information arising from litigation which may relate to the subject matter of the above-identified patent application. By filing this paper, the Applicant is making a good faith attempt to provide the United States Patent and Trademark Office with sufficient information to clearly inform the Examiner of the nature and substance of the issues delineated in § 2001.06(c) so that the Examiner can evaluate the issues as well as the need for additional information or material.

Outlined below is a general description of various allegations made by the parties in litigation involving certain pending applications assigned to James Hardie International Finance B.V. These applications include the present application, and U.S. Application Nos. 10/648,184, 10/648,009, and International Application Nos. PCT/AU2004/000241, PCT/AU2003/001067, which will be referred to collectively as "the James Hardie applications." The allegations were made in the following two litigation matters:

1. *James Hardie Building Products, Inc., et al. v. Energy and Environmental Research Center, et al. (Originally in the Superior Court of California, County of San Bernardino, Central Division; removed to the United States District Court for the Central District of California; Case No. 5:04-CV-00674-RT-SGL; before Judge Robert J. Timlin).*
2. *University of North Dakota, an Arm of the State of North Dakota v. James Hardie Research Pty. Ltd., an Australian Corporation, et al. (Originally in the North Dakota District Court for the Northeast Central Judicial District of North Dakota; removed to the United States District Court for the District of North Dakota; Case No. 04-CV-152; before Judge Ralph R. Erickson).*

In the first case, James Hardie Building Products, Inc. and James Hardie International Finance B.V. brought a contract claim against Energy and Environmental Research Center (“EERC”) for return of a furnace. In the second case, the University of North Dakota (“UND”), EERC’s parent entity, sued James Hardie Research Pty Ltd., James Hardie Building Products, Inc., James Hardie International Finance B.V., and other parties, including Knobbe, Martens, Olson & Bear, LLP and CGC Products, alleging misappropriation of EERC’s trade secrets. As one example of this alleged misappropriation, EERC cited publication of its alleged trade secrets through the filing of the James Hardie applications. The first case was eventually consolidated with the second case in the United States District Court for the District of North Dakota (“the North Dakota court”). For convenience, the James Hardie entities identified above will be referred to collectively as “James Hardie.”

During the course of litigation, EERC filed three patent applications which claimed priority as continuations of certain of the James Hardie applications, including the present application. EERC’s applications copied claims and included different inventorship from these James Hardie applications. In particular, EERC filed the following:

Application No. 11/031,751

- Claims priority as a continuation of the present application
- Copies part or all of original claims 1-23 of the present application
- Inventorship as listed on Application Data Sheet – Amlan Datta, Hamid Hojaji, David L. Melmeth, James A. McFarlane, Thinh Pham, Noel E.

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Docket No. HARD1.090A2
Customer No. 20,995

Thompson, Huagang Zhang, Steven A. Benson, Jason Laumb, Don McCollor,
James Tibbetts

Application No. 11/031,406

- Claims priority as a continuation of James Hardie's pending application No. 10/648,184
- Copies part or all of original claims 1-15, 17, 22-24, 26-32 of James Hardie's pending application No. 10/648,184
- Inventorship as listed on Application Data Sheet – Amlan Datta, Hamid Hojaji, David L. Melmeth, James A. McFarlane, Thinh Pham, Noel E. Thompson, Huagang Zhang, Steven A. Benson, Jason Laumb, Don McCollor, James Tibbetts

Application No. 11/031,829

- Claims priority as a continuation of James Hardie's pending application No. 10/787,894
- Copies part or all of original claims 3, 7, 8, 10, 16-18, 29, 35, 37-40, 64, 70, and 72-75 of James Hardie's pending application No. 10/787,894
- Inventorship as listed on Application Data Sheet – Hamid Hojaji, Shannon Marie Labernik, Thinh Pham, Huagang Zhang, Steven A. Benson, Jason Laumb, Don McCollor, James Tibbetts

In a different application, EERC also copied Claim 5 from the present application but did not name any of the inventors listed in the present application. However, Applicant notes that all of the above mentioned EERC patent applications are or should have been withdrawn as the North Dakota court granted a preliminary injunction for James Hardie ordering EERC to withdraw all of its patent applications which copied, claimed priority from, or which otherwise related to the James Hardie applications, including but not limited to EERC's applications described above.¹

During the course of litigation, UND and EERC have asserted that the inventorship of the James Hardie applications, including the present application, was incorrect because various

¹ Previously, UND obtained a temporary restraining order against James Hardie preventing James Hardie from disclosing UND's alleged trade secrets and from publishing the James Hardie applications. This order has since expired. UND also moved for a preliminary injunction against James Hardie, but the North Dakota court denied this motion.

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EERC employees should have been named as co-inventors. EERC further indicated that the Applicant was not involved in developing the invention identified in at least one claim of the present application. EERC also asserted that James Hardie committed fraud by prosecuting applications with incorrect inventorship. In addition, UND made a general allegation that certain subject matter claimed in one or more of the James Hardie applications is unpatentable. Applicant has reviewed the inventorship of the above-identified patent application and believes that the inventorship is correct. Applicant also disagrees with UND's general allegation of unpatentability. Finally, Applicant notes that the North Dakota court has not yet formed any conclusions on the merits of UND's or EERC's allegations.

Applicant has enclosed for the Examiner's consideration litigation documents that include some of the aforementioned allegations. On the attached PTO Form SB/08, Applicant has grouped these documents under the heading, "Litigation Documents Corresponding to Civil Case Nos. SCVSS115246, 5:04-CV-00674-RT-SGL, 04-C-1621, 05-CV-44, and 04-CV-152."² These documents are listed below by date, case number, and docket number (where applicable):

- Summons and Complaint of UND, 12/15/04, Case No. 04-C-1621, #1, 2 (exhibits not included)
- Brief in Support of Motion to Enforce Ex Parte TRO, 1/11/05, Case No. 04-CV-152, #13
 - Attached: Exhibit C, Declaration of Thomas Erickson (other exhibits and briefs not included)
- Revised Brief in Support of UND's PI Motion, 1/19/05, Case No. 04-CV-152, #19 (exhibits not included)
- Report and Recommendation on UND's PI Motion, 1/31/05, Case No. 04-CV-152, #54
- Order Adopting the Report and Recommendation, 2/4/05, Case No. 04-CV-152, #64
- UND's Opposition to James Hardie's Motion for Preliminary Injunction Hearing Slides, 4/21/05, Case No. 04-CV-152 (docket number unavailable)

² Because the two litigation matters were both originally filed in state court, there are two additional case numbers (SCVSS115246 and 04-C-1621) corresponding to the state court proceedings of these matters. The third additional case number (05-CV-44) corresponds to the

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- James Hardie Preliminary Injunction Hearing Transcript, 4/21/05, Case No. 04-CV-152 (docket number unavailable)
- Order on James Hardie's Motion for Preliminary Injunction, 5/2/05, Case No. 04-CV-152, #88
- Order Amending James Hardie Preliminary Injunction Opinion, 5/11/05, Case No. 04-CV-152, #92
- UND's Answers to James Hardie's First Set of Interrogatories to Plaintiff, 6/6/05, Case No. 04-CV-152 (docket number unavailable)
- Civil Docket for Case No. SCVSS115246 as of July 15, 2005
- Civil Docket for Case No. 5:04-CV-00674-RT-SGL as of July 15, 2005
- Civil Docket for Case No. 04-C-1621 as of July 18, 2005
- Civil Docket for Case No. 05-CV-44 as of July 15, 2005
- Civil Docket for Case No. 04-CV-152 as of July 5, 2005

UND's general allegation of unpatentability is included, for example, in the document entitled "Preliminary Injunction Hearing Transcript." EERC's and UND's allegations of incorrect inventorship are included in several of the documents.

In addition to the aforementioned documents, EERC and UND have filed other documents under seal that further elaborate their theories of inventorship. One of these documents briefly alleges fraud by James Hardie in prosecuting applications with incorrect inventorship. These documents are listed on the docket sheets described above. In addition, certain exhibits of the documents that Applicant is submitting were also filed under seal. Applicant is therefore not submitting the sealed documents or exhibits to the Examiner. Should the Examiner desires further documents listed on the docket sheets or additional information related to the litigation, Applicant will be pleased to submit such documents and information to the extent that it can be done without violating any applicable protective orders.

This Information Disclosure Statement is being filed before the mailing date of a final action and before the mailing of a Notice of Allowance. The Commissioner is hereby authorized

California case (5:04-CV-00674-RT-SGL) after it was transferred to North Dakota and prior to its consolidation with the 04-CV-152 case.


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to charge any additional fees which may be required or to credit any overpayment to Account No. 11-1410.

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 8/31/05

By: 
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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Multiple sheets used when necessary)

SHEET 1 OF 1

Application No.	10/648,585
Filing Date	August 25, 2003
First Named Inventor	Datta, et al.
Art Unit	Unknown
Examiner	Unknown
Attorney Docket No.	HARD1.090A2

U.S. PATENT DOCUMENTS

Examiner Initials	Cite No.	Document Number Number - Kind Code (if known) Example: 1,234,567 B1	Publication Date MM-DD-YYYY	Name of Patentee or Applicant	Pages, Columns, Lines Where Relevant Passages or Relevant Figures Appear

FOREIGN PATENT DOCUMENTS

Examiner Initials	Cite No.	Foreign Patent Document Country Code-Number-Kind Code Example: JP 1234567 A1	Publication Date MM-DD-YYYY	Name of Patentee or Applicant	Pages, Columns, Lines Where Relevant Passages or Relevant Figures Appear	T ¹

NON PATENT LITERATURE DOCUMENTS

Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ¹
	1	Litigation Documents Corresponding to Civil Case Nos. SCVSS115246, 5:04-CV-00674-RT-SGL, 04-C-1621, 05-CV-44, AND 04-CV-152.	

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Examiner Signature

Date Considered

*Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

T¹ - Place a check mark in this area when an English language Translation is attached.